

REMARKS

Applicants acknowledge receipt of the Examiner's Office Action dated January 16, 2009. The Office Action rejects Claims 30-33 under 35 U.S.C. §101 as being directed to non-statutory subject matter. The Office Action rejects Claims 25-29 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Lastly, Claims 1-11 and 25-33 were rejected under 35 U.S.C. §103 as being unpatentable over Gillespie, Market Overview: Electronic Presentation and Payment. In light of the foregoing amendments and following remarks, Applicants respectfully request the Examiner's reconsideration and reexamination of all pending claims.

Claims 25-33 are cancelled, thereby obviating rejections under 35 U.S.C. §101 or 35 U.S.C. §112, second paragraph. Applicants reserve the right to prosecute these claims in this application or in a continuation application.

As noted above, Claims 1-11 were rejected under 35 U.S.C. §103 as being unpatentable over Gillespie. When rejecting a claim under 35 U.S.C. §103, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142 and 2143.

The Gillespie reference does not qualify as prior art under 35 U.S.C. §103. Gillespie is dated November 28, 2001, which is a date subsequent to June 24, 2000, the filing date of the instant application. Because Gillespie is not a prior art reference, the Office Action has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103.

In a prior Office Action dated December 17, 2004, the Examiner argues that page 11 of Gillespie teaches a method of electronic invoice presentation and payment, including EBPP (Electronic Bill Presentation and Payment) and EIPP (Electronic Invoice Presentment and Payment). Page 11 of Gillespie is said to list a number of major providers of EPP products. The list is said to show EPP start dates of major vendors, such as Alltel, Avolent, BC Emergis, etc. For example, Alltell is said to have an EPP start date of 1998. The prior Office Action acknowledges that Gillespie is dated subsequent to the filing date of the instant application. The Office Action asserts that the reference is clear that the claim method and underlying technology were enabling prior to the filing date of the instant application. The prior Office Action provides no basis for this assertion other than the existence of the document itself. Applicants respond by noting Gillespie may have been written in error. Is it not possible that in fact EBPP and EIPP were first used after the filing date of the instant application?

The prior Office Action asserts, “The Applicant takes Official Notice that the EBPP and EIPP read on the language of Claims 1-2.” Applicants do not take Official Notice that the “EBPP and EIPP” read on the language of Claims 1 and 2, either in their current form or prior to amendments thereto.

On page 11 of Gillespie, EPP is defined as “electronic presentment and payment: encompasses both bills and invoices;” EBPP is defined as “electronic bill presentment and payment: distinguishes bills (from invoices or EIPP) to denote consumer recipient (versus corporate recipient);” and EIPP is defined as “electronic invoice presentment and payment: distinguishes invoices (from bills, EBPP) to denote corporate or business recipients (versus consumer recipient).” The Final Office Action maintains the rejection set forth in the December 17, 2004 Non-Final Rejection. In the Final Rejection, the Examiner indicates he is applying the broadest reasonable interpretation to the claims, which includes a consumer logging onto a billing consolidation system and viewing the bill. The Examiner also indicates that he reads the summary and detail billing information of independent Claim 1 to be a single bill. Applicants note that independent Claim 1 should not be limited to the Examiner’s interpretation set forth on pages 2 and 3 of the Final Office Action. Notwithstanding, relevant limitations of, for example, independent Claim 1 have been ignored. For example, although Gillespie may define EPP as electronic presentment and payment, EBPP as electronic bill presentment and payment, and EIPP as electronic invoice presentment and payment, nothing within the cited section of Gillespie teaches or fairly suggests electronically presenting a bill or invoice in response to receiving a request for summary billing information. The invoices or bills that are “electronically presented” by the EPP products of Gillespie, may be presented autonomously or without ever receiving a request for summary billing information. The invoices or bills of the EPP products may be presented electronically in response to a determination that the billable entity is late in payment, rather than in response to receiving a request from the billable entity.

Ultimately, independent Claim 1 contains narrow limitations that are not taught in the cited sections of Gillespie. As such, the Office Actions have failed to establish a *prima facie* basis for rejecting the claims under 35 U.S.C. §103.

The Office Action with respect to limitations contained in dependent Claims 2-10, argues that “It would have been obvious for one skilled in the art to have software to bill provider and/or the bill viewer as motivated by the benefits of delivering software over the Internet. Applicants are not sure how this relates to limitations of the dependent claims. The Office Action asserts that “This process would inherently include providing a URL locator.” However, the Office Action does not identify which “process” is being referred to. Further, the Office Action dismisses dependent Claims 5-7 as failing to limit the method claim. Applicants respectfully disagree. Each of dependent Claims 4-6 provide limitations to the method. For example, dependent Claim 5 requires providing software that comprises one contiguous portion of dynamic HTML as opposed to two or more noncontiguous portions of XML. Ignoring the limitations of dependent Claims 5-7 violates the principle that the claim as a whole must be considered when determining if it meets the non-obviousness standard of 35 U.S.C. §103. Accordingly, Applicants submit that the Office Action has failed to provide a *prima facie* basis for rejecting claims 1-11 under 35 U.S.C. §103.

CONCLUSION

In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance without any further examination and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. Applicant also hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to Deposit Account 502306.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'E. Stephenson', with a long horizontal flourish extending to the right.

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